

REMARKS

Applicants respectfully request reconsideration of the instant application in view of the preceding amendments and/or the following remarks. Claims 1-14 are currently pending and claims 1, 5, 10, and 13 are independent. Claims 1, 5, 10, and 13 have been amended by way of this Amendment/Response to provide clarification, better track practices, reflect implementations, and/or correct informalities. Applicants submit that support for the amendments may be found throughout the originally filed specification, claims and drawings and that no new matter has been added by way of this Amendment/Response.

Claim Rejections – 35 USC § 103

Claims 1-14 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 7,167,910 (hereinafter "Farnham") in view of U.S. Patent Application No. 20040158611 (hereinafter "Daniell"). It should be noted that Farnham was filed June 4, 2002, which is less than ten months earlier than Applicants' earliest priority date of March 14, 2003 and it is not conceded that Farnham was filed in the US before the invention by the Applicants. It should also be noted that Daniell was filed February 10, 2003, which is less than five weeks earlier than Applicants' earliest priority date of March 14, 2003 and it is not conceded that Daniell was filed in the US before the invention by the Applicants. Without so conceding, Applicants respectfully traverse the Examiner's rejection and submit that a *prima facie* case of obviousness has not been established and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and

- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that, by over-generalizing cited references, the rejections in the October 2, 2008 Office Action do not establish at least either of the first two elements of a prima facie case of obviousness. Independent claim 1 recites, *inter alia*,

1. A computer-implemented method ...
 - receiving into the memory an identifier identifying a person and requesting links with a predefined specified number of degrees of separation; ...
 - an indication of one or more disconnects between the identified person and the one or more other persons, wherein the disconnect indicates a separation in time regarding the link associating the identified person with the one or more other persons.

The pending rejection alleges,

"Farnham teaches a system and a method comprising: ... receiving into the memory an identifier identifying a person and requesting links with a predefined specified number of degrees of separation (Figure 1, elements 110, 112, 114 and 116, wherein a social map/network can be created based on adjusted groupings, in particular the lowest degree of separation includes individuals with whom at least a predetermined number of email correspondence was exchanged (column 4, lines 62-67 and column 5, lines 1-4)); ...

(See, October 2, 2008 Office Action, pages 2-3)

Applicants respectfully traverse this argument and submit that the Office Action mischaracterizes claim components and/or aspects of Farnham. By way of example only, the pending rejection alleges that the "predefined specified number of degrees of separation" of the claim corresponds to "the lowest degree of separation includes individuals with whom at least a predetermined number of email correspondence was exchanged" (See, pages 2-3, October 2, 2008 Office Action). Applicants respectfully point out that nowhere in the cited portion of Farnham (or elsewhere in the remainder thereof) is there any mention, let alone discussion, of "degrees of separation". Instead, the portion of Farnham cited by the Examiner states "[t]he number of occurrences for each individual is the number of times that person appears as a recipient or sender of an email" (See, Farnham, column 4, lines 62-67). Moreover, there is no

discussion in the rejection as to how "the number of times [a] person appears as a recipient or sender of email" is allegedly equivalent to the "predefined specified number of degrees of separation" aspect of claim 1. As such, Applicants respectfully submit that Farnham's "number of times that person appears as a recipient or sender of an email" is clearly not "predefined specified number of degrees of separation", as recited by independent claim 1.

The pending rejection also notes that Farnham "does not explicitly teach that an indication of one or more disconnects between the identified person and the one or more other persons, wherein the disconnect indicates a separation in time regarding the link associating the identified person with the one or more other persons" (See, page 3, October 2, 2008 Office Action). However, the Examiner then alleges that this deficiency of Farnham is remedied by Daniell, which the Examiner asserts

teaches a system for displaying social network in a form of a Instant Messenger list wherein a main user can easily view which of his/her friends from the social network are online and which one are offline (i.e. indication of disconnect indicating separation in time because those individuals are currently unavailable) (paragraph [0062], and also illustrated in figure 7).

(See, October 2, 2008 Office Action, page 3)

Applicants respectfully traverse this argument and submit that the cited portion of Daniell in no way addresses "disconnects... wherein the disconnect indicates a separation in time regarding the link associating the identified person with the one or more other persons" as required by claim 1. Instead, paragraph [0062] of Daniell discusses "providing presence information.... presence information can be represented as states such as: 1=online-present; 2=online-away; 3=online-extended away; 4=online-do not disturb; and 5=offline: where, a present state indicates the user is available for a chat session" and makes no mention of "disconnects", let alone "an indication of one or more disconnects between the identified person and the one or more other persons, wherein the disconnect indicates a separation in time regarding the link associating the identified person with the one or more other persons" as required by claim 1.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "All words in a

claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. Applicants submit that, by over-generalizing the cited references, the pending rejection fails to consider "all words in [the] claim," as required, for example, by MPEP § 2143.03. For at least these reasons, Applicants further submit that Farnham and Daniell, alone or in combination, do not discuss or render obvious at least the claim elements discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of the Examiner's rejection.

Furthermore, Applicants submit that the pending rejection has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, "Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill." The pending rejection refers to, "one of ordinary skill in the art," (e.g., October 2, 2008 Office Action, p. 3) but has provided no indication or discussion of which art is described or the level of ordinary skill associated therewith. The rejection's reference to "the art" is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry."

Applicants also submit that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicants respectfully request that, if the Examiner maintains this rejection, the Examiner discuss the level of ordinary skill in the art at the time of the invention and clarify how the claimed subject matter would have allegedly been obvious to one possessing that level of skill.

Although of different scope than claim 1, claims 5, 10 and 13 have been rejected by the Examiner for the same reasons as claim 1. As such, Applicants submit that claims 5, 10 and 13 are patentable over Farnham in view of Daniell for at least similar reasons as discussed above. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of the Examiner's rejections.

Furthermore, Applicants submit claims 2-4, 6-9, 11-12 and 14, which are directly or indirectly dependent from independent claims 1, 5, 10 and 13, respectively, are also not discussed or rendered obvious by the cited references, taken alone or in combination, for at least the reasons discussed above. Accordingly, Applicants request reconsideration and withdrawal of this basis of the Examiner's rejections.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicants respectfully submit that the supporting remarks and claimed inventions, claims 1-14, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicants believe that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed, Applicants assert that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserve the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicants does not concede that any claim elements have been anticipated and/or rendered

obvious by any of the cited reference(s). Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-310. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-310.

Respectfully submitted,
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Dated: March 2, 2009

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